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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,447	08/14/2001	Ippei Nakamura	003510-107	8126

7590

03/20/2003

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EXAMINER

CHU, JOHN S Y

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,447

Applicant(s)

NAKAMURA ET AL

Examiner

John S. Chu

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the application filed August 14, 2001.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms ether-type and alcohol-type are indefinite under 35 U.S.C. 112, second paragraph based on the decision of *Ex Parte Copenhaver*, POBA, 1955, 109 USPQ 118-119.

Correction is necessary.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 rejected under 35 U.S.C. 103(a) as being unpatentable over KONDO et al.

The claimed invention is drawn to a negative-image recording material for heat-mode exposure, the material comprising (A) an IR absorber; (B) a radical generator having an onium salt structure; (C) a radical-polymerizing compound; and (D) a reducing additive; the material being recordable by exposure with IR radiation.

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KONDO et al discloses an image recording material comprising an enol ether compound having two or more ethylenically unsaturated groups, a radiant-ray absorbing material (e.g. carbon black dispersing agent), an acid precursor dissolved in a solvent.

Column 6, line 11 – column 7, line 49 disclose the suitable infrared absorbing material, meeting the claimed IR-absorber of ingredient (A) in claim 1. The enol ethers are recited in column 7, line 50 – column 19, line 44. This disclosure meets the claimed (C) component being a radical-polymerizing compound as recited in claim 1.

While column 19, line 45 – column 33, line 16 disclose the suitable acid-generating compound to include onium salts such as diazonium, phosphonium salts, iodonium salts, and sulfonium salts to be used in the composition. This disclosure meets the claimed (B) radical generator having an onium salt structure.

The reducing additive is disclosed by KONDO et al in column 35, lines 49-50 for the coating solvent such as isopropyl alcohol which meets the recited component (D) as the reducing agent. Isopropyl alcohol is a known hydrogen donor and clearly meets the scope of claims 1 and 2 for the reducing agent.

KONDO et al lacks an explicit example having the presence of isopropyl alcohol as the coating solvent and thus having a reducing agent present in the photosensitive composition.

It would have been *prima facie* obvious to one of ordinary skill in the art of photosensitive composition to use isopropyl alcohol as a coating solvent in the photosensitive coating compositions of KONDO et al as taught and suggested by KONDO et al in column 35, line 50 and reasonably expect same or similar results as recited in reference for recording by infrared light in a direct-plate making system as recited in the examples.

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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. HOZUMI et al '008 and '463 are cited of interest for disclosing divinyl ether components in a photopolymerizable composition with cyclohexanol as a coating solvent, wherein the cyclohexanol can be seen as a reducing agent.

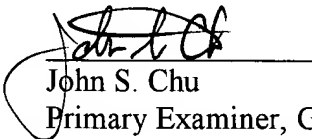
CUNNINGHAM et al , SCHULTZ et al, HATTORI et al are cited to disclose photopolymerizable composition with a phosphine photoinitiator which can also be seen as a reducing agent.

KAWAUCHI et al is cited as the U.S. patent version of the cited EP reference in the PTO-1449.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


John S. Chu
Primary Examiner, Group 1700

J.Chu
March 17, 2003